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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,235	02/25/2002	Michael John Reed	674519-2001.4	6335
20999	7590	11/04/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			BADIO, BARBARA P	
			ART UNIT	PAPER NUMBER

1616

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/084,235

Applicant(s)

REED ET AL.

Examiner

Barbara P. Badio, Ph.D.

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/238,345.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **Final Office Action**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Status of the Application***

2. Claims 6-20 are pending in the present application and will be examined to the extent they on compounds wherein the polycycle ring system is a steroid.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in United Kingdom on 03/05/1996; 03/19/1996; 02/16/1996 and 12/05/1996. It is noted, however, that applicant has not filed a certified copy of the above cited applications as required by 35 U.S.C. 119(b).

### ***Double Patenting***

4. The rejection of claim 8 under 35 USC 101 over claim 2 of prior US Patent No. 6,187,766 is withdrawn.
5. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of US Patent No. 5,616,574 is maintained claims 12-16 and 19 are rejected under the judicially

Art Unit: 1616

**created doctrine of obviousness-type double patenting over claims of US Patent No. 5,616,574.**

**6. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of US Patent No. 6,187,766 is maintained claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of US Patent No. 6,187,766.**

**7. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of US Patent No. 6,642,397 is maintained and claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of US Patent No. 6,642,397.**

**8. The rejection of claims 6, 7, 9-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No. 09/755,429 (US Patent No. 6,653,298) is withdrawn and claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No. 09/755,429 (US Patent No. 6,653,298).**

- 9. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of copending Application No. 09/794,853 is maintained and claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No.09/794,853.**
- 10. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No.10/013,798 is withdrawn and claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No.10/013,798.**
- 11. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No.10/165,599 is maintained and claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No.10/165,599.**
- 12. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No.10/367,622 is maintained and claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No.10/367,622.**

Art Unit: 1616

13. The rejection of claims 6-11, 17, 18 and 20 under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No. 09/572,237 (US Patent No. 6,670,353) is maintained and claims 12-16 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting over claims of copending Application No. 09/572,237 (US Patent No. 6,670,353).

***Claim Rejections - 35 USC § 103***

14. The rejection of claims 6-11, 17, 18 and 20 under 35 USC 103(a) over Registry Handbook (1984 Supplement) in view of Schwarz et al. (DD 114806) and Hirsch ('351) is withdrawn.

***Other Matters***

15. Applicant held double patenting rejections in abeyance.

***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 1616

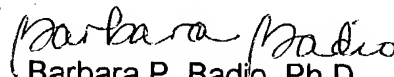
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Telephone Inquiry***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB  
November 3, 2004